

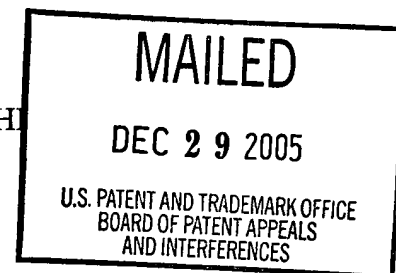
The opinion in support of the decision being entered today was not written for publication in a law journal and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte AKIHIKO KOH, TSUTOMU SAMPEI,
NOBUSHISA WATANABE and AKIHIRO KIKUCHI

Application No. 09/802,857



ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was received at the Board of Patent Appeals and Interferences on November 17, 2005. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the Examiner. The matters requiring attention prior to docketing are identified below.

APPEAL BRIEF

A review of the file indicates that on April 22, 2005, appellants filed an Appeal Brief under the rules set forth in 37 CFR § 41.37(c). However, the Appeal Brief filed on

October 14, 2004, does not fully comply with the new rules under 37 CFR § 41.37(c).

37 CFR § 41.37(c) states in part:

(c)(1) The brief shall contain the following items under appropriate headings and in the order indicated in paragraphs (c)(1)(I) through (c)(1)(x) of this section, except that a brief filed by an appellant who is not represented by a registered practitioner need only substantially comply with paragraphs (c)(1)(i) through (c)(1)(iv) and (c)(1)(vii) through (c)(1)(x) of this section:

(x) ***Related proceedings appendix.*** An appendix containing copies of decisions rendered by a court or the Board in any proceeding identified pursuant to paragraph (c)(1)(ii) of this section.

(2) A brief shall not include any new or non-admitted amendment, or any new or non-admitted affidavit or other evidence. See § 1.116 of this title for amendments, affidavits or other evidence filed after final action but before or with any appeal and § 41.33 for amendments, affidavits or other evidence filed after the date of the appeal.

(d) If a brief is filed which does not comply with all the requirements of paragraph (c) of this section, appellant will be notified of the reasons for non-compliance and given a time period within which to file an amended brief. If appellant does not file an amended brief within the set time period, or files an amended brief which does not overcome all the reasons for non-compliance stated in the notification, the appeal will stand dismissed.

An in-depth review of the Appeal Brief indicates that the following sections are missing from the Appeal Brief filed April 22, 2005:

1) "Related Proceedings Appendix," as set forth in 37 CFR § 41.37(c)(1)(x).

It is required that a supplemental Appeal Brief be submitted that is in compliance with 37 CFR § 41.37(c). For more information on the Board's new rules, please see the web page entitled "More Information on the Rules of Practice Before the BPAI," Final Rule at:

<http://www.uspto.gov/web/offices/dcom/bpai/fr2004/moreinfo.html>.

EXAMINER'S ANSWER

On August 9, 2005, an Examiner's Answer was mailed. A review of the Examiner's Answer reveals that it is not in compliance with the headings as set forth in the new rules under 37 CFR § 41.37 which went into affect September 13, 2004. Accordingly, correction is required.

REPLY BRIEF

A Reply Brief in response to the Examiner's Answer mailed August 9, 2005, was filed on October 11, 2005. However, a review the Image File Wrapper (IFW) reveals that the Reply Brief has not been considered or acknowledged by the examiner.

A written communication notifying appellant of the Examiner's receipt and consideration of the Reply Brief is required.

Accordingly, it is

ORDERED that the application is returned to the examiner to:

- 1) hold the Appeal Brief filed on April 22, 2005, defective;
- 2) to notify appellants to file a supplemental Appeal Brief in compliance with 37 CFR § 41.37;
- 3) to vacate the Examiner's Answer mailed August 9, 2005, to consider the supplemental Appeal Brief; and submit a revised Examiner's Answer in accordance with the new rules effective September 13, 2004;

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4) proper acknowledgment and consideration of any Reply Brief filed in response to the substitute Appeal Brief; and

5) for such further action as may be appropriate.

BOARD OF PATENT APPEALS
AND INTERFERENCES



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